

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Peter Kassan

Application No.: 10/671,194

Confirmation No.: 6395

Filed: September 25, 2003

Art Unit: 3625

For: SYSTEM FOR PRODUCING MAGAZINES
FROM WEB SITES ON DEMAND

Examiner: W. J. Allen

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within three months of the Notice of Appeal filed in this case on February 12, 2007, with a one month extension of time fee, and is in furtherance of said Notice of Appeal.

The fee of \$500.00 required under Section 1.17(f) is submitted herewith.).

In the event a fee is required or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-2215.

CONTINGENT EXTENSION REQUEST

If this communication is filed after the shortened statutory time period had elapsed and no separate Petition is enclosed, the Commissioner of Patents and

Trademarks is petitioned, under 37 CFR 1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 CFR 1.135. The fee under 37 CFR 1.17 should be charged to our Deposit Account No. 50-2215.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- Appendix A Claims
- Appendix B Evidence
- Appendix C Related Proceedings

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Web Bindery LLC

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 52 claims pending in application.

B. Current Status of Claims

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: 28
3. Claims pending: 1-52
4. Claims allowed: None
5. Claims rejected: 1-27 and 29-52

C. Claims On Appeal

The claims on appeal are claims 1-27 and 29-52.

IV. STATUS OF AMENDMENTS

Appellant filed an Amendment After Final Rejection on January 9, 2007. The Examiner responded to the Amendment After Final Rejection in an Advisory Action mailed January 26, 2007. In the Advisory Action, the Examiner indicated that Appellants' proposed amendments to claims 29 and request for reconsideration had been considered.

Accordingly, the claims enclosed herein as Appendix A incorporate the amendments to claims 29, as indicated in the paper filed by Appellant on January 9, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Claim 1 recites:

1. A method for providing printed pages of web hosted information in response to an electronic request received over a communication network (**Abstract, Figures 5-7, Paragraph 18**), the method comprising:

providing add-in software operable with a web site, the add-in software enabling a visitor of the web site to submit a request for receiving a printed copy of web hosted information that is displayable as web pages (**Paragraphs 29-31**);

receiving electronic order information representing the request (**Paragraphs 31, 33, S100**);

processing the electronic order information to provide electronic production information representing instructions for fulfilling the request (**Paragraphs 33, 34, S106**);

transmitting the electronic production information to a fulfillment facility (**Paragraphs 32, S300**); and

providing to the visitor the requested web hosted information from the fulfillment facility in the form of printed pages (**Paragraphs 34, S314**).

B. Claim 29 recites:

29. A system for providing formatted print pages that comprise content represented in a web site (**Abstract, Figs. 2,4**), the system comprising:

add-in software operable with the web site, the add-in software enabling a visitor of the web site to submit an electronic request for the formatted print pages of web hosted information displayable as web pages (**Paragraphs 19, 31, 37**);

a request receiving module (**38**) that receives the electronic request over a communication network (**Paragraphs 33, Figs. 2,3**);

a request processing module that processes the contents of the electronic request and provides electronic production information that provides instructions for fulfilling the electronic request (**Paragraphs 19, 32-34, Fig. 2**);

a transmitting module that transmits the electronic production information to a fulfillment facility operable to provide the formatted print pages corresponding with the electronic production information (**Paragraphs 32-34, Fig. 2**); and

a formatted print pages delivery module operable to provide to the visitor the formatted print pages (**Paragraphs 32-34, Fig. 2**).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The rejection of claims 1, 2, 8, 12, 13, 15, 18-20, 23, 24, 29, 40, 44, 46, 47, 50, and 51 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. US2003/0069811 ("Ximenes").
- B. The rejection of claims 3-6, 41-43, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Ximenes in view of U.S. Patent No. 4,839,829 ("Freedman").
- C. The rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Ximenes in view of Faster Finishing for Quick Printing ("Oller" PTO 892X).
- D. The rejection of claims 9 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Ximenes in view of U.S. Patent Publication 2003/0208718 ("Mulvey").
- E. The rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Ximenes in view of Mulvey and in further view of U.S. Publication No. 2002/0010630 ("Fischer").
- F. The rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Ximenes in view of Mixed Media ("Estell" PTO 892U).

- G. The rejection of claims 16, 17, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Ximenes in view of Analysis for Financial Management ("Higgins" PTO 892V).
- H. The rejection of claims 21, 22, and 30-39 under 35 U.S.C. § 103(a) as being unpatentable over Ximenes in view of U.S. Patent No. 6,535,294 ("Arledge").
- I. The rejection of claims 27 and 48-49 under 35 U.S.C. § 103(a) as being unpatentable over Ximenes in view of Snapfish (892 PTO UU).
- J. The rejection of claim 52 under 35 U.S.C. § 103(a) as being unpatentable over Ximenes in view of How to Get the Most Out of Reprints ("Rouse" PTO 892 VV).

VII. ARGUMENT

Claims 1-521 are pending in this application. Claims 1-27 and 29-52 stand rejected and claim 28 is withdrawn from consideration. Appellant respectfully submits that each of the pending claims is in immediate condition for allowance and requests that the Board order the withdrawal of the pending rejections.

- A. Claims 1 and 29 are not anticipated by U.S. Patent Publication No. US2003/0069811 ("Ximenes")

Claims 1 and 29 were improperly rejected under 35 U.S.C. § 102(e) as being anticipated by Ximenes. Appellant submits that Ximenes fails to anticipate claims 1 and 29.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See, PPG

¹ Claims 1-27 and 29-52 are presently on appeal. Appellant presents arguments with respect to independent claims 1 and 29 as each of the dependant claims stand or fall together with the independent claim from which they depend. The dependent claims are not argued separately.

Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir. 1991).

1. Ximenes fails to disclose printing web hosted information displayable as web pages

Among the limitations of independent Claim 1 not present in Ximenes is “enabling a visitor of the website to submit a request for receiving a printed copy of web hosted information that is displayable as web pages.” Likewise, claim 29 reads “enabling a visitor of the web site to submit an electronic request for the formatted print pages of web hosted information displayable as web pages.” Specifically, Ximenes fails to disclose web hosted information displayable as web pages.

Ximenes discloses a system whereby a user selects an image from a collection of images that are displayed on a web page that is then printed at a fulfillment facility. However, Ximenes does not disclose printing web hosted information **displayable as web pages**. Ximenes merely discloses the printing of images that are **displayed on a web page** i.e., images in a catalog that is displayed to the user.

In Ximenes, a method and apparatus for producing reproduction of visual images on demand is disclosed. A collection of visual images (thumbnails) is presented to a user. The user can select from these visual images and order a reproduction which is produced at a printing facility. See Ximenes paragraph 15. In detail, a patron accesses a catalog 108 via a portal 106. The patron then identifies a visual image to be reproduced from the catalog 108 and provides payment information to an ordering server 104. See Ximenes paragraph 20. Once the order is made, an ordering server

104 accesses a print file 105 associated with the identified visual image. The print file 105 provides the necessary information to a print facility 107 to produce the reproduction specified in the order. It should be noted that, as shown in Ximenes, a series of images is presented to a user on a web page. The user then selects an image which is then printed by a print facility.

In the Final Office Action, the Examiner stated that Ximenes discloses printing web hosted information displayable as web pages for at least four reasons. Those four reasons are:

- (i) The catalog/library server and ordering server are connected by the web/internet to the ordering portal (see at least: 0007);
- (ii) The catalog/library contains information on visual images available for selection and reproduction, with the library visual images accessible by the user through the ordering portal via the web/internet (see at least: Abstract, 0020);
- (iii) For each image in the library there is a displayable reproduction of the image (see at least: 0036, 0040);
- (iv) Using web client with a web browser, the user accesses the catalog/library of visual images hosted on the web server (see at least: Abstract, 0020).

See Final Office Action at 3.

Appellant respectfully disagrees that any of the four items above either alone or in combination disclose the capability of printing web hosted information displayable as web pages.

With respect to point (i), Appellant agrees that the catalog/library server and ordering server are connected by the web to the ordering portal. However, in Ximenes, the users are not able to print web pages from the catalog/library server. In Ximenes, it is the catalog that is displayed as web pages. But Ximenes does not teach or even

suggest that users have the ability to print the catalog as taught and claimed by the present application. The users can merely interact with the catalog server to search available images and specify a format for the reproduction of the image. However, there is no disclosure of printing the catalog in Ximenes which might arguably read on the claimed limitation of printing web hosted information displayable as web pages.

With respect to point (ii), Appellant agrees that the catalog/library server contains information identifying visual images available for reproduction. Again, however, the individual visual images displayed on Ximenes' catalog that are available for reproduction are not web hosted information displayable as web pages as required by claims 1 and 29. They are merely images **displayed on a web page** via the internet. Therefore, the Examiner's second point above fails to anticipate the quoted claim term.

With respect to point (iii), Appellant agrees that for each image in the library, there is a displayable reproduction of the image. The displayable image is displayed to the user at a lower resolution. In fact, as shown in Figure 5, the displayable reproduction image, i.e., the low resolution image is presented to the user as a virtual museum. However, at no time does Ximenes display these images as web pages that can be printed.

Finally, with respect to point (iv) above, the visual images hosted on the web server are just that, individual images that can be ordered as a reproduction. However, the user is ordering a reproduction of the low resolution image displayed as part of the virtual tour. At no time can the user order the printing web hosted information displayable as web pages nor does Ximenes ever disclose web hosted information displayable as web pages.

Appellants note that Ximenes discloses presenting low resolution images to a user via a web interface. The user can then order high resolution versions of these low resolution images, via a fulfillment facility. This is unlike the disclosed and claimed invention. Simply put, the individual images disclosed in Ximenes in no way can be considered “web hosted information displayable as web pages.” These images are indeed displayed on web pages, but Ximenes never discloses the ability to print the web page as currently required by claims 1 and 29.

As recited in Claims 1 and 29, a visitor of the website can “submit a request for receiving a printed copy of web hosted information as displayable as web pages.” As set forth in the claim, Appellant is not claiming the printing of a specific image that is displayed on a web page and having it printed a fulfillment center but rather the user in Appellant’s invention as recited in claims 1 and 20 request a printed copy of information displayable as web pages. Thus, Ximenes fails to anticipate Claims 1 and 29.

In the Advisory Action, the Examiner notes that Appellant’s disclosure is directed “more to the ordering of formatted print pages” and that the recitation of content “displayable as web pages” is generically recited in passing in the specification and claims. Appellant submits that as an Applicant for a patent, the Applicant has a right to use claim language and to adjust the scope and breadth of a claim as desired. See, In re Zletz, 893 F.2d 319, 321 (13 U.S.P.Q.2d 1320, Fed. Cir. 1989). Thus, the Examiner’s assertion that the specification is directed more towards one topic than another is irrelevant to the actual material recited in the pending claims. Therefore, the only issue before the Board is the improper rejection of the pending claims in view of Ximenes.

2. Dependent claims

Appellant notes that, as discussed above, only the independent claims are being argued. The dependent claims stand rejected over Ximenes as applied to the independent claims in view of additional references which, even if they were to disclose the subject matter for which they are used, fail to cure the deficiencies in Ximenes discussed above, therefore, all of the dependent claims are in condition for allowance.

Claims 2-27 depend either directly or indirectly from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Ximenes and are directed towards patentable subject matter. Thus, claims 2-27 should also be allowed.

Claims 30-52 depend either directly or indirectly from, and contain all the limitations of claim 29. These dependent claims also recite additional limitations which, in combination with the limitations of claim 29, are neither disclosed nor suggested by Ximenes and are also directed towards patentable subject matter. Thus, claims 30-52 should also be allowed.

B. Conclusion

In view of the arguments set forth above, Appellant respectfully submits that each of the pending claims is in immediate condition for allowance and requests that the Board order the withdrawal of the pending rejections.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Appellant on January 9, 2007.

Dated:

Respectfully submitted,

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/671,194

1. (Original) A method for providing printed pages of web hosted information in response to an electronic request received over a communication network, the method comprising:

providing add-in software operable with a web site, the add-in software enabling a visitor of the web site to submit a request for receiving a printed copy of web hosted information that is displayable as web pages;

receiving electronic order information representing the request;

processing the electronic order information to provide electronic production information representing instructions for fulfilling the request;

transmitting the electronic production information to a fulfillment facility;

and

providing to the visitor the requested web hosted information from the fulfillment facility in the form of printed pages.

2. (Original) The method of claim 1, wherein the electronic order information is prepared by the add-in software.

3. (Original) The method of claim 1, further comprising providing an estimate for costs associated with providing the printed pages.

4. (Original) The method of claim 3, wherein the estimate is partly based on a requested style for the printed pages.

5. (Original) The method of claim 4, wherein the style includes at least one of binding, saddle-stitching, paper size, two-sided printing and full-bleed printing.

6. (Original) The method of claim 4, wherein the add-in software enables the visitor to select a predefined layout and to modify the predefined layout.

7. (Original) The method of claim 1, wherein the printed pages are provided by printing on oversized paper and trimming the oversized paper to appear as produced by full-bleed printing.

8. (Original) The method of claim 1, wherein the step of preparing the electronic order information comprises selecting a style for the printed pages, the style including at least one of page layout, inside and outside of a front cover, inside and outside of a back cover, double-sided printing, and single-sided printing.

9. (Original) The method of claim 8, wherein the step of choosing the style includes making a selection from a plurality of thumbnail images, each of the plurality of thumbnail images representing a style.

10. (Original) The method of claim 9, wherein the visitor provides a request a modification to the style.

11. (Original) The method of claim 10, wherein the request is provided by email.

12. (Original) The method of claim 8, wherein the step of choosing the style includes at least one of generating a new style and modifying an existing style.

13. (Original) The method of claim 1, wherein the print pages are packaged with at least one other item.

14. (Original) The method of claim 13, wherein the at least one other item includes advertising material.

15. (Original) The method of claim 1, wherein the step of processing the electronic order information comprises providing at least one of front information, back information and spine information.

16. (Original) The method of claim 15, wherein the front information comprises at least one of a table of contents, forward and advertising.

17. The method of claim 15, wherein the back information comprises at least one of an index, an appendix, a table and a glossary.

18. (Original) The method of claim 1, wherein the add-in software further enables a user to provide at least one of related personal and professional information.

19. (Original) The method of claim 1, wherein the add-in software further provides customer web site information, the customer web site information regarding at least one of the uniform resource locator of the web site, the IP address of the web site and the name of the proprietor of the web site.

20. (Original) The method of claim 1, further comprising providing a production web site, the production web site providing prospective customers information regarding providing the printed pages.

21. (Original) The method of claim 20, wherein the production web site further provides restricted access to registered users.

22. (Original) The method of claim 21, wherein the restricted access enables registered users to receive electronic information regarding orders for printed materials.

23. (Original) The method of claim 1, wherein the fulfillment facility provides the printed pages such that they have been subject to at least one of folding, binding and saddle stitching.

24. (Original) The method of claim 1, further comprising at least one of transmitting an invoice for the printed pages and receiving electronic payments for providing the printed pages.

25. (Original) The method of claim 1, wherein the printed pages further comprise ownership information.

26. (Original) The method of claim 25, wherein the ownership information includes copyright information and production information, the production information including information regarding the fulfillment facility.

27. (Original) The method of claim 1, further comprising storing a style in a database corresponding to respective visitors, and selecting a stored style for respective visitors in future production of printed pages.

28. (Withdrawn, Not part of Appeal) A remotely controlled method for the production of bound books responsive to individual book orders, the method comprising:

- providing access via an Internet connection to a plurality of remote potential book buyers in the form of web pages that display at least a portion of the contents of books for perusal and review;
- operating a facility that enables the potential remote book buyer to place an order or orders for one or more selected books;
- processing orders for books whose contents are represented by web pages;
- communicating the order, including selection and the ordered book's content to a fulfillment facility;
- executing at the fulfillment facility a series of steps that convert the communications into a bound book; and
- delivering the book to the book buyer.

29. (Previously Presented) A system for providing formatted print pages that comprise content represented in a web site, the system comprising:

add-in software operable with the web site, the add-in software enabling a visitor of the web site to submit an electronic request for the formatted print pages of web hosted information displayable as web pages;

a request receiving module that receives the electronic request over a communication network;

a request processing module that processes the contents of the electronic request and provides electronic production information that provides instructions for fulfilling the electronic request;

a transmitting module that transmits the electronic production information to a fulfillment facility operable to provide the formatted print pages corresponding with the electronic production information; and

a formatted print pages delivery module operable to provide to the visitor the formatted print pages.

30. (Original) The system of claim 29, further comprising a production information processor providing the add-in software, the production information processor further providing a production web site, the production web site comprising at least public content for registered and non-registered visitors, and private content for registered visitors.

31. (Original) The system of claim 30, wherein the public content comprises information regarding at least one of the add-in software, the request receiving module, the request processing module, the transmitting module and the formatted print pages delivery module.

32. (Original) The system of claim 30, wherein the private content comprises at least one of content received from the web site and content not received from the web site, wherein the content is to be included in the formatted print pages.

33. (Original) The system of claim 30, further comprising a search module, the search module providing a location of content related to content provided in the web site.

34. (Original) The system of claim 33, wherein content located by the search module is included in the formatted print pages.

35. (Original) The system of claim 30, further comprising at least one of a laser printer, a bubble jet printer, an ink jet printer, a dye emulsion printer, and a full-bleed printer.

36. (Original) The system of claim 30, wherein the electronic request includes electronic content information representing the content for the formatted print pages, and control information representing at least a style of the formatted print pages.

37. (Original) The system of claim 36, wherein the control information further comprises at least one of an identification of the web site, the portion of the web site for the formatted print pages, and the version of the formatted print pages.

38. (Original) The system of claim 36, wherein the control information further comprises at least one of the name, mailing address, shipping specifications and e-mail address of the party submitting the electronic request.

39. (Original) The system of claim 36, wherein the style of the formatted print pages includes at least one of the front matter, the back matter, and components that are repeated in the formatted print pages.

40. (Original) The system of claim 29, wherein the communication network is the Internet.

41. (Original) The system of claim 29, further comprising a formatted print pages style module that provides a selection of at least one formatted print pages style template.

42. (Original) The system of claim 41, wherein the at least one formatted print pages style template is used to produce formatted print pages that comply with a formatted print pages style.

43. (Original) The system of claim 41, wherein the formatted print pages style module provides tools for manipulating a selected formatted print pages style template.

44. (Original) The system of claim 29, further comprising a simulation module that provides an electronic simulated representation of the formatted print pages.

45. (Original) The system of claim 44, further comprising an approval module that prompts the viewer for approval after the simulation module provides the electronic simulated representation of the formatted print pages.

46. (Original) The system of claim 44, wherein the electronic simulation is at least a partial representation of the formatted print pages.

47. (Original) The system of claim 44, wherein the electronic request comprises the electronic simulated representation.

48. (Original) The system of claim 29, further comprising a subscription module that prompts the visitor to enter into a subscription agreement for receiving future formatted print pages.

49. (Original) The system of claim 46, wherein a single payment for a plurality of orders for formatted print pages is provided by the visitor.

50. (Original) The system of claim 29, further comprising an e-commerce module performs at least one of generating a cost for receiving formatted print pages and accepting payment for formatted print pages.

51. (Original) The system of claim 29, wherein the formatted print pages include at least one of a company annual report, a wall calendar, a desk calendar and a poster.

52. (Original) The system of claim 29, wherein the content comprises an article in a previously printed magazine.

APPENDIX B

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

APPENDIX C

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.